

REMARKS

In reply to the office action mailed May 16, 2007, Applicants have amended claims 1 and 9. Please consider the following remarks.

35 U.S.C. 103

Claims 1-7 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2006/0252751 to Xue et al. ("Xue") and U.S. 2005/0245741 to Hossain et. al. ("Hossain"). Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. 102, shall not preclude patentability under 35 U.S.C. 103 where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Applicants submit that the subject matter in Hossain and the claimed invention, were at the time the claimed invention was made, owned or subject to an obligation of assignment to the same person. Therefore, Applicants submit that Hossain can not be properly relied upon as the basis for a rejection under 35 U.S.C. 103(a).

Xue discloses compounds that include a pyrrolidine ring moiety adjacent to a cyclohexyl moiety. The claimed compounds do not recite a cyclic nitrogen containing moiety anywhere in the structure, much less a pyrrolidine ring. Rather, the claimed compounds recite a secondary nitrogen adjacent to a cycloalkyl moiety, and do not allow for ring formation of the secondary nitrogen. Moreover, the Examiner has not provided a reason that would lead one skilled in the art to make the modification necessary to arrive at the claimed compounds. The Federal Circuit has held that "in cases involving new compositions of matter, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound." (Takeda v. Alphapharm, June 28, 2007.) Applicants submit that because the Examiner has failed to identify a reason to make the required modifications to arrive at the claimed compounds, a *prima facie* case of obviousness cannot be maintained. Applicants therefore request that the rejection be withdrawn.

35 U.S.C. 112

Claims 1-7 and 9 were rejected under 35 U.S.C. 112, first paragraph, as lacking enablement. Applicants submit that one skilled in the art would be able, using routine

experimentation, to make and use the claimed compounds as required under 35 U.S.C. 112. Applicants further submit that the law does not require that these compounds be made in high yield or with optimized procedures as suggested by the Examiner. Moreover, the law does not require that the claimed compounds be made from commercially available starting materials. Rather, Applicants submit that the high skill in the art, combined with the guidance in the specification would allow the claimed compounds to be made with routine experimentation.

Applicants submit that the Examiner's recitation that certain recited chemical groups could not undergo the synthetic procedures given is not determinative. For example, protecting groups are routinely used in synthetic chemistry. Moreover, Applicants are not required to provide every example of methods to make the claimed compound, and submit that alternative synthetic routes from those provided in the specification would be within the ordinary skill in the art. Accordingly, Applicants submit that the pending claims satisfy the enablement requirement and request that the corresponding rejection be withdrawn.

Claims 1 and 9 were rejected based on the inclusion of the term "solvate." Applicants have cancelled this term and therefore request that the corresponding rejection be withdrawn.

Double Patenting

Claims 1-7 and 9 were provisionally rejected on the ground of nonstatutory double patenting over the following co-pending applications: 10/579,545, 10/581,171, 10/583,468, 10/520,699, 11/744,659, and 11/744,677. Applicants request that the rejection be held in abeyance until the claims of at least one of the applications have been found otherwise allowable.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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